

Interview Summary

Application No.

09/615,039

Applicant(s)

MORIN ET AL.

Examiner

Michael C. Wilson

Art Unit

1632

All participants (applicant, applicant's representative, PTO personnel):

(1) Michael C. Wilson.

(3) _____.

(2) Michael Shiff.

(4) _____.

Date of Interview: 20 May 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: _____.

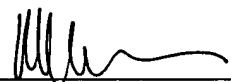
Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner Wilson called to inform Mr. Schiff that the response to the restriction had not been received. Mr. Schiff agreed to fax the response to Examiner Wilson at 703-746-5276. The response fax was sent to Examiner Wilson on 5-20-03, dated 8-29-02 which stated applicants elected Group I. However, the transmittal sheet clearly shows that the transmission failed (see "Confirmation Report" on pg 6 of fax sent 5-30-03, "*** SEND FAILED ***"). Applicants failed to respond to the restriction requirement sent 5-29-02; therefore, the application is hereby abandoned.

geron

GERON CORPORATION

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Facsimile Transmittal Sheet

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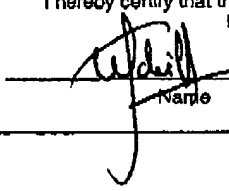
Date: May 20, 2003

To: Mike Wilson, Ph.D.
U.S. Patent & Trademark Office
Phone: 703-305-0120
Fax: 703-746-5276

From: J. Michael Schiff
Associate Director, Intellectual Property
Geron Corporation
Phone: 650-473-7715
Fax: 650-473-8654

Number of pages including cover: 7 (last page marked)

*Copy of Response to Restriction filed August 29, 2002
USSN 09/615,039
as you requested.*

CERTIFICATE OF FACSIMILE TRANSMISSION	
I hereby certify that this correspondence is being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.8(d) on the date indicated.	
 _____ Name	August 29, 2002 _____ Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Gregg B. Morin et al.

Filing Date: July 11, 2000

Serial No: 09/615.039

Docket: 09/615,039

Title: ONCOLYTIC VIRUS THAT REPLICATES
IN CELLS EXPRESSING TELOMERASE
REVERSE TRANSCRIPTASE

Art Unit: 1632

Examiner: [unknown]

GERON IP GROUP

SEP 03 2002

DOCKETED

**INTERVIEW SUMMARY
AND
RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents and Trademarks
Washington, D.C. 20231

Dear Sir,

This paper provides a Summary of telephone interviews conducted with the Office with regards to the Requirement for Restriction in this application. The Commissioner is respectfully requested to recognize that the telephone election was properly made on May 28, 2002, and is responsive to the Restriction Requirement subsequently sent in writing on May 29, 2002.

Please enter the following remarks.

PATENT
09/615.039
Docket 019/251c

Interview

On May 26, 2002, Examiner Qian Janice Li left a telephone message inquiring as to why applicant had not responded to the Restriction Requirement mailed on October 3, 2001. A return message was left at Examiner Li's number on the same date.

On May 28, Examiner Li and the undersigned spoke by telephone. It was determined that the Restriction Requirement of October 3, 2001 had been mailed to the wrong address. Examiner Li indicated that a Restriction had been made between the following inventions:

- Group I: Claims 27-38 and 40, drawn to recombinant virus and its production
- Group II: Claim 39, drawn to a method of screening
- Group III: Claims 41-46, drawn to methods of using recombinant virus

As representative of the assignee, the undersigned elected *Group I for prosecution on the merits without traverse*. The undersigned also authorized the Commissioner to charge any fees required for extensions of time or reinstatement of the application to applicant's deposit account.

Examiner Li indicated that she would check with her supervisor regarding whether an extension of time would be required, and undertook to prepare an Office Action on the merits forthwith.

The undersigned then spoke to Examiner Deborah Reynolds. Examiner Reynolds indicated that the time for responding to the Restriction Requirement would be restarted, and that the election made by telephone would be entered and forwarded with the case to a new examiner for preparation of the first Office Action.

On May 29, 2002, the Office mailed a written Restriction Requirement. The undersigned did not consider that a written response was considered necessary, since the election had already been properly made by telephone, and would be entered in due course. However, as of August 29, 2002, the Patent Application Information Retrieval (PAIR) system still indicates that the election has still not been entered.

Applicant respectfully requests that the telephone election of May 28, 2002 be entered into the application file as of that date. In the alternative, applicant requests that this paper be considered responsive to the pending Restriction Requirement.

PATENT
09/615,039
Docket 019/251c

Request for expedited prosecution

The examination of this application on the merits has already been delayed by *10 months*, due to the mailing of the Restriction Requirement of October 3, 2001 to the wrong address, and the failure of the Office to enter the telephone election made on May 28, 2002.

These errors by the Office have prejudiced applicant's patent protection for this important invention, which has current commercial interest, and is subject to an important license agreement with revenue implications.

As a remedy, applicant respectfully requests that an Office Action on the merits be prepared forthwith, and that the subsequent prosecution of this application proceed with dispatch.

Conclusion

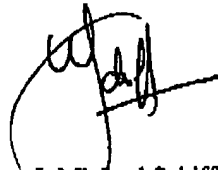
Applicant requests that the application proceed to examination on the merits, in view of the amendment and remarks made herein. In the event the Examiner determines that an interview would facilitate prosecution of this application, he or she is invited to contact applicant's representative at the telephone number indicated below.

Applicant respectfully submits that no extension of time is required for entering this paper or responding to the Restriction Requirement, since a proper election was previously made by telephone on May 28, 2002.

PATENT
09/615,039
Docket 019/251c

However, should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Assistant Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



J. Michael Schiff
Registration No. 40,253

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August 29, 2002

Confirmation Report - Memory Send

Time : 29-Aug-2002 20:23
Tel line : +6504738654
Name : GERON CORP

Job number : 391
Date : 29-Aug 20:20
To : 91703305917033059014
Document pages : 006
Start time : 29-Aug 20:20
End time : 29-Aug 20:23
Pages sent : 000
Status : NG BO

Job number : 391 *** SEND FAILED ***

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Date: August 29, 2002
To: U.S. Patent & Trademark Office
Fax: 703-303-3014
From: J. Michael Schiff
Geron Corporation
Fax: 650-473-7715
Phone: 650-473-8654
Number of pages including cover: 6 (last page marked)

OFFICIAL FILING

USPN 09/616,039

Please enter this paper into the Patent File

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LAST PAGE